

## REMARKS

### **I. INTRODUCTION**

Claims 2-17 are pending. Reconsideration of the present application is respectfully requested.

### **II. REJECTION OF CLAIMS 17, 6-8, 13 AND 14 UNDER 35 U.S.C. § 102(e)**

Claims 17, 6 to 8, 13 and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,292,440 ("Lee"). It is respectfully submitted that Lee does not anticipate these claims for at least the following reasons.

Claim 17 relates to a device for playing back multimedia files stored in an automotive environment, which includes, inter alia, a storage device and a processor for decoding the multimedia files. Claim 17 recites that the processor includes an element for displaying directories located in the storage device and in which the multimedia data files are contained, as different data carriers.

Lee purports to relate to a MP3 car player having a large memory to temporarily store audio data received from a compact disk (CD) player so that interruptions in the playing of the audio data caused by bumpy road conditions are prevented. See Lee, Abstract, col. 1, lines 6 to 10. In this regard, the MP3 player uses both conventional CDs and MP3 CD-ROMs, and is capable of compressing and decompressing audio data at a high compression ratio to allow the recording of 150~200 songs on a single CD-ROM, and thereby remove the need for the expensive CD changer often used with CD players installed in automobiles. See Lee, Abstract, col. 1, lines 10 to 12 and lines 36 to 42. The MP3 player includes a large memory block 203 to temporarily store MP3 audio files transferred from a CD-ROM. See Lee, col. 3 lines 24 to 25. The MP3 player also includes an LCD interface 301 to display titles of the audio data and track numbers, and a keypad interface unit 302 having play, pause, next, and back keys to control the operation of the MP3 player. See Lee, Figure 1, col. 4, lines 10 to 19. In this regard, it is respectfully submitted that the LCD interface 301 does not display directories located in the memory block 203 as different data carriers, as required to anticipate the features of claim 17. Indeed, Lee does not discuss a display of directories, or even the existence of a directory structure. Hence, the reference relied upon does not identically describe (or even suggest) the features of claim 17 -- as it must to support an anticipation rejection. It is therefore respectfully submitted that claim 17, as well as any claims that depend from claim 17, including claims 6 to 8, 13 and 14, are

allowable over the reference relied upon.

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

In view of the foregoing, withdrawal of the anticipation rejections is respectfully requested.

### **III. REJECTION OF CLAIMS 17, 2-4, 6-8 AND 10-16 UNDER 35 U.S.C. § 103**

Claims 17, 2 to 4, 6 to 8, and 10 to 16 stand rejected under 35 U.S.C. § 103 as being obvious over US 2002/0046048 to Steele et al. (the "Steele application"). It is respectfully submitted that the Steele application does not render these claims obvious for at least the following reasons.

The Steele application purports to relate to an in-car device 20, which allows any AM, FM, TV audio, or digital audio broadcast or any Internet audio broadcast to be easily selected by format (i.e., country, classical, news, rock, talk, etc.) without requiring the user of the device 20 to know the band or frequency of a particular station. See the Steele application, col. 1, paragraph [0022]. In this regard, the in-car device 20 displays the available broadcast stations using a hierarchically organized tree structure, in which the root of the tree contains major categories (e.g., music, talk, TV audio, etc.), under each major category are subcategories (e.g., blues, classical, country, dance, etc.), and under each subcategory are the available station channels (e.g., WNEW, KSLX, SOLD, KROK, etc.). See the Steele application, col. 3, paragraphs [0049] to [0052]. It is respectfully submitted, however, that the hierarchical tree is not a display of directories located in a storage device in which multimedia files are contained, but rather merely an organized display of the available station operators whose broadcast signals can be received by the device 20.

In regards to storing multimedia files, the Steele application refers to a storage device 92 that stores MP3 audio files but does not refer to displaying directories on the storage device 92 as different data carriers. See the Steele application, col. 3, paragraph

[0046]. Indeed, a display of directories located on the storage device 92 is not discussed at all. Instead, merely the titles of the MP3 audio files located on the storage device 92 are displayed. See the Steele application, Figure 5. Accordingly, the Steele application fails to disclose or even suggest a processor which includes an element for displaying directories located in a storage device and in which the multimedia files are contained, as different data carriers.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must describe or suggest each claim element and it must also provide a motivation or suggestion for modifying the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Accordingly, even if it were proper to modify the Lee reference as suggested (which is not conceded), it is respectfully submitted that the Steele application does not render claim 17 obvious, or any claims that depend from claim 17, including, claims 2 to 4, 6 to 8 and 10 to 16, for at least the reason that the Steele application does not disclose all of the limitations of claim 17, in particular, the limitations of a processor for decoding the multimedia data files, which includes an element for displaying directories located in a storage device and in which the multimedia data files are contained, as different data carriers. Indeed, the Office Action admits on page 4 that the “Steele fails to disclose the processor decoding the multimedia files.”

Moreover, the Office Action’s assertion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Steele by incorporating the technique of decoding the multimedia files (audio) for the purpose of regenerating the contents of the files in its original format for adequate output” is mere hindsight reasoning for at least the reason that the alleged motivation is simply not found in the Steele application. The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that a subjective “obvious to try” standard is not proper. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted). In short, there must be evidence of why a person having ordinary skill in the art would be motivated to modify a reference to provide the claimed subject matter of the claims.

Still further, it is respectfully submitted that a *prima facie* case of obviousness has not been made in the present case, since the Office Action never made any findings, such as, for example, regarding what the ordinary skill level in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the factual predicates underlying a *prima facie* obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art)). It is respectfully submitted that the proper test for showing obviousness is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art, and that the Patent Office must provide particular findings in this regard -- the evidence for which does not include broad conclusory statements standing alone. (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made concerning the identification of the relevant art, the level of ordinary skill in the art or the nature of the problem to be solved))). It is again respectfully submitted that there has been no such showing by the Office Action.

In fact, it is again respectfully submitted that the lack of any of the required factual findings in the Office Action forces Applicants to resort to unwarranted speculation to ascertain exactly what facts underly the present rejections. The law requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Office has failed to carry the initial burden of presenting a proper *prima facie* case of obviousness. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, for at least these reasons, it is respectfully submitted that the

Steele application does not render claims 17, 2 to 4, 6 to 8 and 10 to 16 obvious. Withdrawal of the rejection based on the Steele application is requested.

### III. REJECTION OF CLAIMS 5 AND 9 UNDER 35 U.S.C. § 103

Claims 5 and 9 stand rejected under 35 U.S.C. § 103 as being obvious over the Steele application. It is respectfully submitted that claims 5 and 9 are not rendered obvious for at least the following reasons.

Claims 5 and 9 recite limitations analogous to claim 17, including a processor for decoding multimedia files, which includes an element for displaying directories located in the storage device and in which the multimedia files are contained, as different data carriers. It is therefore respectfully submitted that claims 5 and 9 are allowable for at the same reason that claim 17 is allowable.

### IV. CONCLUSION

Each of the issues raised by the Examiner has been addressed. It is respectfully submitted that the present application is in condition for allowance. Passage to issuance is requested.

Respectfully submitted,

KENYON & KENYON

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By: \_\_\_\_\_

Richard L. Mayer  
Reg. No. 22,490

KENYON & KENYON

One Broadway  
New York, NY 10004  
(212) 425-7200

Customer Number 26646